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CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420			KRISCIUNAS, LINDA MARY	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/916,951	FERGUSSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Linda Krisciunas	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8-26 and 28-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-26 and 28-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This is a FINAL OFFICE ACTION in response to the applicant's amendments filed December 29, 2005. The examiner's last name has changed from Morawski to Krisciunas. The applicant has amended claims 1-4, 8-13, 15-17, 19-26, and 28-30 and cancelled claims 7 and 27 and added new claims 31-35.

#### ***Response to Amendments***

2. The applicant has filled in the blank spaces in the specification, therefore this objection is withdrawn. The claims have been re-numbered, therefore this objection is withdrawn.

The applicant's amendments have been considered and are deemed to be amended significantly such that a new art search has been required. The rejections are listed below.

Claims 31-35 that were added were considered and the rejections are listed below.

#### ***Response to Arguments***

3. With respect to claims 1-6 and 8-9, the amended language limits the claim with respect to the business having a number of representatives and each representative representing particular customers and providing a customized list of customers to each representative, with each representative providing literature to the customized list. This language introduces the art of distributing workload, which is typically done for the purpose of expediting or logistical reasons. This limitation is taught by Melchione as the list of leads is sent to the branch offices and then to the personal bankers within the

branch. The personal bankers are equivalent to the representatives since they perform the same function in substantially the same manner with substantially the same results. The sales sessions indicated by Melchione are equivalent to distributing marketing material as it performs an identical function in substantially the same manner with substantially the same results. The efficacy indicator is taught by Melchione (column 9, line 67-column 10, lines 1-6) since it captures daily sales information which is a direct indicator of the efficacy of the marketing that has been performed.

4. With respect to claim 10, the amended limitations list the representatives with customized lists of customers (see the explanation for claim 1), and sending marketing material that is personalized. Melchione teaches (column 9, lines 58-65: "the personal bankers use the CCIS to view a complete profile of the customer's relationship with the bank and any other demographic information about the customer contained on the central database. This allows the personal banker to speak intelligently with the customer during the sales session and thereby increase the success rate of the marketing campaign." The fact that the banker is looking up personal information on the customer and then using that to customize the sales session is equivalent to personalizing the marketing material.

5. With respect to claim 19, Melchione does not explicitly teach the limitation related to checking the material for compliance with applicable rules and regulations resulting in compliant material. 17 CFR Part 248 addresses the compliance issue since any banking or financial transactions have various requirements and rules and regulation that must be adhered to for security reasons. Therefore it would have been obvious to one of

ordinary skill in the art of the finance/banking industry to make their material and procedures compliant with these mandated laws.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-18 and 20-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Melchione et al. (US 5,930,764).

As per claim 1, Melchione teaches a method for monitoring the efficacy of a marketing project for a product of a business, the method comprising the steps of: providing a customer database (10) for storing information about the customers of the business; providing a number of marketing project parameters (32); applying the number of marketing project parameters against the information in the customer database to identify selected customers (column 9, lines 1-5); notifying at least some of the selected customers about the product (column 27, lines 45-48); determining which of the customers that were notified about the product actually purchased the product; and determining a marketing project efficacy indicator (column 9, line 67 and column 10 lines 1-6) by noting which of the customers that were notified about the product actually purchased the product (column 40, line 59 and column 6, lines 49-51).

As per claim 2, Melchione teaches a method wherein the marketing project efficacy indicator is determined by comparing the number of customers that were notified about the product with the number of the customers that were notified about the product and actually purchased the product. (Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the sales generated from that.)

As per claim 3, Melchione teaches a method wherein the marketing project efficacy indicator is determined by comparing the number of customers that were notified about the product with the number of the customers that were notified about the product and did not purchase the product. (Melchione also discloses a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the sales generated from that.)

As per claim 4, Melchione teaches a method further comprising the step of monitoring revenues generated from the purchase of the product by the customers that were notified about the product. (Revenue calculations (column 41, line 66) would monitor revenues generated from product sales.)

As per claim 5, Melchione teaches a method wherein the marketing project efficacy indicator is determined by comparing the revenues generated from the sale of

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the marketed product relative to a revenue goal. (Revenue calculations (column 41, line 66) and goal reports (column 41, line 51) are efficacy indicators.)

As per claim 6, Melchione teaches a method wherein the marketing project efficacy indicator is determined by comparing the number of products sold versus a goal. (Revenue calculations (column 41, line 66) and goal reports (column 41, line 51) would be efficacy indicators.)

As per claim 8, Melchione teaches a method of modifying the marketing material if the marketing project efficacy indicator is deemed to be too low. (Means for modifying said campaign if not optimal, wherein the campaign encompasses all aspects of the marketing program (column 10, lines 4-6).)

As per claim 9, Melchione teaches a method of modifying selected marketing project parameters if the marketing project efficacy indicator is deemed to be too low. (Means for modifying said campaign if not optimal, wherein the campaign encompasses all aspects of the marketing program (column 10, lines 4-6).)

As per claim 10, Melchione teaches a method for marketing a product to customers of a business, wherein the business has a number of representatives, and each representative represents a portion of the customers, the method comprising the steps of: providing a customer database for storing information about the customers of the business(10); providing a number of marketing project parameters (32); applying the number of marketing project parameters against the information in the customer

database to identify selected customers (column 9, lines 1-5); providing at least a partial listing of the selected customers to one or more of the representatives; at least some of the representatives providing information about the product to at least some of their customers listed on the at least partial listing. (Melchione teaches the concept of “representatives” and their contact with customers (column 62, lines 31-34) wherein the branch workstations are deemed equivalent to the term “representative” as they perform the identical function in substantially the same manner and produce substantially the same results.)

As per claim 11, Melchione teaches a method for monitoring how many and/or which of the customers that were provided marketing information about the product actually purchased the product from a representative of the business. (Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the sales generated from that. If the person was notified about the product it is deemed equivalent to receiving marketing information as this performs the same function in substantially the same manner and produces substantially the same result.)

As per claim 12, Melchione teaches a method of determining a marketing project efficacy indicator for the marketing project by examining which of the customers that were provided with marketing information about the product actually purchased the product. (Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers



notified about the product and the sales generated from that. If the person was notified about the product it is deemed equivalent to receiving marketing information as this performs the same function in substantially the same manner and produces substantially the same result.)

As per claim 13, Melchione teaches a method wherein the marketing project efficacy indicator is determined by comparing the number of customers that were provided marketing information with the number of those customers that were provided marketing information that actually purchased the product from a representative of the business.(Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the sales generated from that. If the person was notified about the product it is deemed equivalent to receiving marketing information as this performs the same function in substantially the same manner and produces substantially the same result.)

As per claim 14, official notice is taken for determining common characteristics for those customers that actually purchased the product from a representative of the business. (Official notice is taken that both the concept and the advantages of determining common characteristics for customers that purchased the product are well known and expected in the art. It would have been obvious to conduct research on customers to better understand their motivation for purchasing the product.)

As per claim 15, Melchione teaches a method of monitoring how many and/or which of the customers that were provided marketing information about the product did not purchase the product from a representative of the business. (Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the number of orders generated, leaving a simple subtraction for determining the number of those that did not purchase the product. If the person was notified about the product it is deemed equivalent to receiving marketing information as this performs the same function in substantially the same manner and produces substantially the same result.)

As per claim 16, Melchione teaches a method for determining a marketing project efficacy indicator for the marketing project by examining which of the customers that were provided with marketing information about the product did not purchase the product. (Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the number of orders generated, leaving a simple subtraction for determining the number of those that did not purchase the product. If the person was notified about the product it is deemed equivalent to receiving marketing information as this performs the same function in substantially the same manner and produces substantially the same result.)

As per claim 17, Melchione teaches that the marketing project efficacy indicator is determined by comparing the number of customers that were provided marketing information with the number of those customers that were provided marketing information that did not purchased the product from a representative of the business. (Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the number of orders generated, leaving a simple subtraction for determining the number of those that did not purchase the product. If the person was notified about the product it is deemed equivalent to receiving marketing information as this performs the same function in substantially the same manner and produces substantially the same result.)

As per claim 18, official notice is taken of a method for determining common characteristics for those customers that did not purchase the product from a representative of the business. (Official notice is taken that both the concept and the advantages of determining common characteristics for customers that did not purchase the product are well known and expected in the art. It would have been obvious to conduct research on customers to better understand their motivation for purchasing and not purchasing the product.)

As per claim 20-22, Melchione teaches a method wherein the at least partial listing of the selected customers is provided to the one or more representatives in a format that is compatible with: printing labels, printing envelopes or post cards and a

merge function of an application program.(Melchione already teaches targeted marketing techniques used including direct mailing, telemarketing and computer banking (column 4, lines 8-37), as well as a means for downloading reports and files to local printers or storage devices (column 8, lines 49-50) and a merge process (column 16, line 33).

As per claim 23-24, Melchione teaches a method wherein the at least partial listing of the selected customers is provided to the one or more representatives in a format that is compatible with a spreadsheet application program and compatible with an e-mail program.(Melchione teaches electronic sales and support (column 14, line 55). Official notice is taken that at the time of the invention the use of e-mail and spreadsheets were well known to those of ordinary skill in the art and would therefore have been obvious to incorporate. In addition, a database can be defined as a spreadsheet and Melchione teaches a database as already noted in claim 1. )

As per claim 25, Melchione teaches a method for marketing a product to customers of a business, wherein the business has a number of representatives, and each representative represents a portion of the customers, the method comprising the steps of: providing a customer database for storing information about the customers of the business (10); providing a number of marketing project parameters (32); applying the number of marketing project parameters against the information in the customer database to identify selected customers (column 9, lines 1-5); providing at least a partial listing of the selected customers to one or more of the representatives; at least some of

the representatives providing information about the product to at least some of their customers listed on the at least partial listing (column 62, lines 31-34); identifying those customer that were provided with information about the product; identifier those customer that actually purchased the product (column 40, line 59); and determining a marketing project efficacy indicator for the marketing project by examining which of the customers that were provided with information about the product actually purchased and/or did not purchase the product. (Melchione teaches a sales tracking and reporting component (column 40, line 59) which can generate various sales reports which would address the customers notified about the product and the sales generated from that. If the person was notified about the product it is deemed equivalent to receiving marketing information as this performs the same function in substantially the same manner and produces substantially the same result.)

As per claim 26, Melchione teaches a method wherein the at least partial listing of selected customers is provided to one or more of the representatives upon initiation by the representative. (See Figure 1A, where the Micromarketing centers or “representatives” request information from the database to obtain the customer information.)

As per claim 28, Melchione teaches a method for making a contact entry in the customer database when a representative contacts a customer about the product; and determining a marketing project appeal indicator by monitoring the contact entries in the

customer database. (Melchione teaches a tracking and reporting management tool for daily sales and to track performance (column 33, lines 61-66).)

As per claim 29, Melchione teaches a method wherein the at least partial listing of the selected customers that is provided to a particular representative only include customers that the particular representative represents. (Melchione teaches leads which are distributed among selected bankers within the branch (column 33, lines 39-45).)

As per claim 30, Melchione teaches a method wherein an identifier for each customer that actually purchased the product is generated by having each representative initiate the recording of each sale of the product in the customer database. (Melchione discloses tracking and reporting management tools for daily sales and to track performance (column 33, lines 61-66).)

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 19 and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melchione, in view of 17 CFR Part 248 which is a financial services regulation related to Privacy of Consumer Information.

As per claim 19, Melchione teaches a method wherein the business is a financial services business, the method further comprising the steps of: generating marketing material; checking the marketing material for compliance with applicable rules and regulations, thereby resulting in compliant marketing material; providing the compliant marketing material, as well as the at least partial listing of selected customers, to the one or more of the representatives. (Melchione teaches the "financial services business" in equivalent terms as a financial institution (column 5, line 61), as well as marketing campaigns (column 8, line 54) which is deemed equivalent to marketing material as it performs an identical function in substantially the same manner and generates substantially the same results. This material is distributed to the "representatives" as previously mentioned in claim 10. Melchione does not explicitly teach the requirement of having financial materials comply with a standard. But, official notice is taken of 17 CFR Part 248 which teaches that it is known for a financial institution to comply with various standards such as those forth in the Gramm-Leach-Bliley Act concerning the Privacy of Consumer Financial Information. Since these are mandated laws in the United States, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the database as taught by Melchione with compliance requirements as taught by 17 CFR Part 248, since such a modification would provide the database with a means for maintaining the current level of security required for financial documents.)

As per claims 31-35, Melchione teaches generating marketing material (column 5, lines, 51-57: "The present invention provides a tool for establishing a long term and

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broad relationship with a customer by allowing those in charge of marketing financial services to access and discuss the full range of financial services presently used by the customer, as well as to only target optimum groups of customers for each marketing campaign conducted"); providing a customer database for storing information about the customers of the business (10); providing a number of marketing project parameters (32); applying the number of marketing project parameters against the information in the customer database to identify selected customers (column 9, lines 1-5); providing the compliant marketing material and a customized listing of the selected customers to at least some of the representatives (column 9, lines 44-52: "The branch managers receive the list of leads generated by the micromarketing center and electronically load the leads into the CCIS workstations for distribution among selected personal bankers within the branch. The branch managers assign the leads to the personal bankers most qualified to handle the leads, or based on the workload and availability of the personal bankers."); and at least some of the representatives providing the compliant marketing material to at least some of the customers listed on their customized listing of selected customers (column 9, lines 55-57: "The personal bankers then conduct sales sessions (e.g., telephone calls) with each of the customers on the list of leads.") and determining common characteristics for the customers that purchased the product (column 7, lines 65-67: "the central database is housed in a mainframe computer and includes a large repository of financial and demographic data." and column 8, lines 17-31: "Thus, the central database serves as a single central repository for storing all customer related information throughout the business. As described hereinafter, the



central database can be used for a wide variety of customer service, financial analysis and marketing purposes. While a single central repository for storing all customer related information throughout a business offers significant potential, the database is necessarily so large that certain problems arise. For example, the present inventors recognize that a database of this size cannot practically be directly searched. Thus, in accordance with another aspect of the present invention, the system of the present invention includes means for allowing users to dynamically build programs for searching the central database" whereby it would be inherent that the database would sort the customers according to common characteristics.). Melchione does not explicitly teach checking the marketing material for compliance. Official notice is taken that 17 CFR Part 248 teaches that it is known to have compliant information in the banking/financial arena as these are mandated laws. Therefore it would have been obvious to one of ordinary skill in the art to combine the customer marketing database system of Melchione with the compliance features of 17 CFR Part 248 to provide a more comprehensive and marketable system.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following art also teaches about marketing systems: Silkey et al (US 2002/0087404), Henning et al (US 2005/0075946), and "Database Marketing

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Leaves Marketing to the Branches" by Katherine Morrall, Bank Marketing, v 26, n 11, p 22-30, Nov 1994.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Krisciunas whose telephone number is 571-272-6931. The examiner can normally be reached on Monday through Friday, 6:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LMK

*LMK*  
*January 19, 2006*

*Susanna Diaz*  
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